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Serial No.: 09/818,240

Confirmation No.: 1590

Filed: 27 March 2001

For: ROLL GOODS DISPENSER SYSTEM AND METHODS OF USE

The 35 U.S.C. §103 Rejections

The Examiner rejected claims 1-17 under 35 U.S.C. §103(a) as being unpatentable over Bishop (U.S. Patent No. 474,518). Applicants respectfully traverse this rejection.

Applicants traverse this rejection and submit that claims 1-17 are not *prima facie* obvious in view of Bishop for at least the following reasons. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings; there must be a reasonable expectation of success; and the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

The Examiner has made this rejection in previous Office Actions, mailed June 10, 2002 and November 19, 2002, and, as has been previously asserted by Applicants, this rejection is traversed for failing to meet the requirements for a *prima facie* case of obviousness as the Office has failed to present a proper motivation or suggestion to modify the teachings of Bishop.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See M.P.E.P. § 2143.01, pages 2100-124 to 2100-125. See also, *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984) (cited by MPEP § 2143.01, pp. 2100-127 (8th Ed., Rev. 1, Feb. 2003)). Modifying Bishop in the proposed manner would render the device taught by Bishop unsatisfactory for its intended purpose, thus negating the asserted motivation or suggestion required for a *prima facie* case of obviousness. Applicants have previously provided comments in support of this assertion, to which, Applicants submit, the Examiner has failed to provide adequate rebuttal.

In response to the Examiner's allegation that the side shields are movable as claimed, Applicants first note that there is no motivation or suggestion identified in the prior art to make such a modification in Bishop. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01, p. 2110-126 (8th Ed., Rev. 1, Feb. 2003)

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(citing *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)). No portion of Bishop has ever been identified as providing support for a finding that the proposed modification would be desirable.

For example, turning one or both end pieces A around would leave the ribbon exposed to external elements and possible damage. This is in direct contrast to the teachings of Bishop, where the case is "designed to furnish a neat package for the ribbon, to completely protect it from damage, rough handling or the oxidizing effect of the atmosphere" (Bishop, page 1, lines 25-28). Thus, the Examiner's comment that the claims do not preclude the ribbon to be exposed to external elements or damage is contrary to the specific teachings of Bishop. Furthermore, the device of Bishop serves as "a holder or reel from which the ribbon may be fed to the ribbon-holder of the machine upon which it is to be used without touching it with the fingers" (Bishop, page 1, lines 28-32). Should one or both end pieces of Bishop be turned, as suggested by the Examiner, it would be inevitable that one would touch the ribbon with one's fingers, which result is also contrary to the teachings of Bishop.

Furthermore, turning one of both of the end pieces of Bishop around as asserted would also result in the lugs B facing away from the core or bobbin on which the ribbon is wound. As discussed in Bishop, the lugs B are provided to support the core or bobbin. Providing them on the outside of the end pieces A would result in the core or bobbin being unsupported. If unsupported, the ribbon would not be retained within the end pieces, thereby further subjecting it to damage. Thus, despite the Examiner's comment that the claims do not require the lugs to support the core when the side shields are facing away from the core, an unsupported core is contrary to the teachings of Bishop. It is additionally pointed out by Applicants that nowhere in either the claims or the specification of Bishop is it recited that the side shields face away from the core and, in fact, claims 1 and 3 recite that the "cup-shaped or flanged" heads of the ribbon package have "their flange edges in proximity."

Applicants, thus, assert that turning one or both end pieces A around as suggested by the Examiner would render Bishop unsatisfactory for its intended purpose of protecting ribbon from damage and oxidation, negating any motivation or suggestion proffered by the Examiner to

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modify Bishop in order to reach a *prima facie* case of obviousness with respect to Applicants' invention. It is further asserted that while the Examiner has provided methods by which Bishop may be modified, no motivation for making any of the suggested modifications has been provided.

For at least the above reasons, Applicants submit that claims 1-17 are not *prima facie* obvious in view of Bishop. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

The Examiner rejected claims 1-10, 18, 19, 21, and 23-25 under 35 U.S.C. §103(a) as being unpatentable over Sweeney (U.S. Patent No. 3,430,886). Applicants respectfully traverse this rejection.

Independent claims 1 and 18 include, *inter alia*, a roll of continuous length product including a core defining a central void within the roll, and a first dispenser guard including a retaining plug protruding from a side shield, wherein the retaining plug is located within the central void. Thus, the present invention provides to the user a dispenser system and method of dispensing a continuous length product wherein a conventional roll of continuous length product including a core, such as adhesive tape, may be located on the retaining plug of the dispenser system, then when the product is used up, the empty core may be removed and a new roll of product may be located on the retaining plug of the dispenser system. Applicants assert that Sweeney fails to teach or suggest Applicants' invention.

Sweeney discloses a one-piece molded bobbin for holding various forms of filament, particularly fishing leader (Sweeney, col. 1, lines 29-31). The body 3 of the bobbin includes a hub portion 4, and a head 5 and 6 at each end of the hub portion for supporting and retaining a winding of filament 7 on the hub portion 4 between heads 5 and 6 (Sweeney, col. 2, lines 19-23 and Fig. 1; emphasis added). The head at each end of the hub portion is required to prevent the wound filament from falling off the bobbin as it is being wound and/or stored after winding. The location of a head at either end of the hub portion precludes a user from locating a

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roll of continuous length product including a core onto the bobbin, since no matter which end of the hub portion the user attempts to install the roll of product, the installation is prevented by interference with one of the heads of the bobbin.

Furthermore, "[i]f [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (cited with approval by M.P.E.P. §2143.01). If the bobbin of Sweeney was modified as proposed in the Office Action to include a core, a filament could not be wound onto the bobbin in the absence of the two opposing heads without the filament falling off. In other words, the proposed modifications would make the bobbin of Sweeney unsatisfactory for its intended purpose of holding filament, such as fishing leader, to permit carriage thereof in a pocket or a tackle box (Sweeney, col. 1, lines 29-38). Thus, there is no proper suggestion or motivation to make the proposed modification as is required for a *prima facie* case of obviousness.

For at least these reasons, Applicants assert that claims 1 and 18, as well as claims 2-10, 19, 21, and 23-25 dependent thereto, are patentable over Sweeney. Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

The Examiner rejected claims 11-17, 26-28, and 30-32 under 35 U.S.C. §103(a) as being unpatentable over Sweeney (U.S. Patent No. 3,430,886) as applied to claims 1-10, 18, 19, 21, and 23-25 above, and further in view of Burger et al. (U.S. Patent No. 4,802,638). Applicants respectfully traverse this rejection.

Applicants point out that independent claims 11 and 26 also include, *inter alia*, a roll of continuous length product including a core defining a central void within the roll, and a first dispenser guard including a retaining plug protruding from a side shield, wherein the retaining plug is located within the central void. In view of the above comments, it is asserted that Sweeney also fails to teach or suggest Applicants' claims 11 and 26, as well as claims 12-17,

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27, 28, and 30-32 dependent thereto. Furthermore, Burger et al. fail to teach or suggest that which is missing from Sweeney.

Burger et al. disclose a one-piece molded cord stowage device including a spool, wherein the excess slack in cable is wound around the spool of the stowage device (Burger et al., Abstract). The spool includes a first and a second cup-shaped member connected to each of the first and second end of the spool (Burger et al., col. 1, lines 43-54 and Figs. 3, 5, 8, and 10). As with the bobbin of Sweeney, the spool of Burger et al. prevents a user from locating a roll of continuous length product including a core onto the spool, since no matter which end of the spool the user attempts to install a roll of product, the installation is prevented by the location of one of the cup-shaped members. Thus, Burger et al. fails to provide for the deficiency of Sweeney.

Furthermore, as was discussed above with respect to the bobbin of Sweeney, the proposed modifications of the bobbins disclosed by Sweeney would render the device unsatisfactory for its intended purpose, since to provide a retaining plug and core of material according to the present invention on the devices of Sweeney or Burger et al. would result in the wound cord falling off the spool. As a result, there is no proper suggestion or motivation to make the proposed modification as is required for a *prima facie* case of obviousness (*See*, M.P.E.P. §2143.01).

For at least the above reasons, Applicants assert that claims 11-17, 26-28, and 30-32 are patentable over Sweeney in view of Burger et al. and reconsideration and withdrawal of the rejection are respectfully requested.

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Summary

It is respectfully submitted that the pending claims 1-32 are in condition for allowance and notification to that effect is respectfully requested.

The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Parents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17th day of March, 2004, at 11:39 a.m. (Central Time).

By: Rachel Gagliardi-GrahamName: Rachel Gagliardi-Graham